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10/692,835

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EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

MAIL DATE	DELIVERY MODE
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09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/692,835

Applicant(s)

FENNELLY, MARTINE

Examiner

Son T. Nguyen

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-77,80-89,91-95 and 98-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-77,80-89,91-95 and 98-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SON T. NGUYEN
PRIMARY EXAMINER

SON T. NGUYEN
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of densities must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 70-77,80-86,89,94,95,98-102** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitations of "...partly off only said withers" (from claim 70), "...elevating only a front portion" (from claim 80), "...prop up only a front portion" (from claim 89), and "...to raise only a frontal portion" (from claim 94) are not supported in the specification. Applicant stated that support can be found on page 16, lines 28 and page 17, line 5 of the specification; however, the Examiner does not find these two excerpts stating that the pad is being propped up or raised **ONLY** the front portion of the withers or only the withers. In addition, no where else in the specification states such only in the front portion or wither. Furthermore, supported by the drawings and described on [0079][0087] are full pads that extend full length from front to back of the spine of the horse (see fig. 3a), thus, the pads raise the front and the back, and not only the front. Also, fig. 3d shows pads 320a,320b,321a,321b raising the front portion and the back portion, but not only the front portion. Even in the description for fig. 3d, [0090], no where does it states that the pads only raised the front portion. Therefore, these added limitations are not supported

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in the specification as alleged by Applicant. In addition, for claim 92, a plurality of densities is not described in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 70-75,91-93** are rejected under 35 U.S.C. 102(b) as being anticipated by Vasko et al.(US 4683709).

For claim 70, Vasko et al. teach a saddle pad apparatus 12 adapted to support a saddle while maintaining both substantially unimpeded movement of the spinal column of a living subject and a desirable balance of a saddle and rider, comprising a first pad 36 disposed laterally to one side of the spine and a second pad 38 disposed laterally to the other side of the spine so that said first and second plurality of pads straddle said spinal column and are sufficiently distant therefrom so as not to impede movement of the spinal column of said living subject by forming a space between said spinal column and said saddle pad apparatus, each of said pads being adapted to individually cooperate with a respective one of withers region gaps or recesses of the anatomy of the living subject; wherein said pads are configured to raise the saddle at least partly off of only said withers region of the animal, so as to substantially avoid contact of said saddle with the top of the withers, thereby substantially eliminating pressure points in said withers region and maintaining said balance. Note that numerous functional

recitations have been incorporated in the claim, to which all functions recited can be performed by the pads of Vasko et al. For example, the pads are adapted to cooperate with a respective one of the withers region gaps or recesses if the user only wishes to use the pads in those area. The pads, nevertheless, can perform the intended function, especially in col. 5, lines 1-10 of Vasko et al., they state that there could be a pocket with two separate inserts, or multiple pockets and inserts. In addition, the pads of Vasko et al. are also configured to raise the saddle at least partly off of only the withers region of the animal if one wishes to do so by only employing the front pads of the multiple pads as stated in col. 5, lines 1-10.

For claim 71, Vasko et al. further teach a third and a fourth pad so that said apparatus comprises four discrete pads, two per side of the spine. See col. 5, lines 5-8.

For claim 72, Vasko et al. further teach wherein at least one of said pads varies in thickness (see figs. 5-8).

For claim 73, Vasko et al. further teach wherein said first and second pads are formed from a visco-elastic foam material (col. 2, lines 65-68 and col. 3, lines 32-48).

For claim 74, Vasko et al. further teach wherein said first and second pads are disposed in pockets 28,30 formed substantially between a first layer 14 of material and a second layer 17 of material.

For claim 75, Vasko et al. further teach wherein said first and second pads are made removable from said pockets via Velcro strips 34,35 disposed at seams of said pockets.

For claim 91, Vasko et al. teach a pad element 36,38 comprising a plurality of rounded edges (for example, fig. 2 where ref. 41 is pointing at) adapted for use in a saddle pad, wherein said pad element is formed from a visco-elastic foam (col. 2, lines 65-68 and col. 3, lines 32-48) and is adapted for selective removal from said saddle pad by a user; and wherein said pad element is particularly shaped to substantially accommodate and fit substantially within a particular withers region recess on the anatomy of an animal on which said pad element and saddle pad is utilized. Note the functional recitation of "adapted" and "shaped to accommodate and fit substantially within", to which the pads of Vasko et al. are capable of performing the intended function.

For claim 92, Vasko et al. further teach wherein said pad element has a plurality of densities (inherently taught because the pad has some sort of density when compressed or uncompressed) associated therewith in its uncompressed state.

For claim 93, Vasko et al. further teach wherein said plurality of densities are substantially stratified with respect to the width dimension of said element. See figs. 5-7 of stratification of the pad element.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. **Claims 76,77,80-89,94,95,98-102** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasko et al. as applied to claims 70,74 above, and further in view of Woods (5802823).

For claim 76, Vasko et al. teach the layers 14,15,17,18 made out of wool felt or woven nylon fabric, which are fiber based material (col. 2, lines 48-59) but Vasko et al. are silent about material (the bottom layer) 17,18 being sheepskin disposed to contact the skin of said living subject.

Woods teaches a saddle pad having a material 62 being sheepskin disposed to contact the skin of said living subject. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the material 17 of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice.

For claim 77, Vasko et al. as modified by Woods further teaches the living subject is an equine.

For claim 80, Vasko et al. teach saddle pad apparatus 12 adapted to support a saddle on a living subject comprising a plurality of pads 36,38 that distribute load from said saddle substantially evenly on said living subject to avoid contact with the living subject's spinal column over only a plurality of non-contiguous regions of said living subject's anatomy such that during riding said saddle is substantially stable around a rotational axis transverse to the longitudinal axis of the spinal column of said subject;

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wherein said plurality of pads are disposed laterally to said spine in pockets 28,30 formed substantially between a first layer 14 comprise wool felt or woven nylon fabric, which are a fiber-based material, and a second layer 17 comprising a fiber-based material (col. 2, lines 47-59), said material layer 17,18 being disposed to contact the skin of said living subject, said fiber-based material layer 14,15 being disposed to contact said saddle. However, Vasko et al. are silent about the pads elevating only a front portion of the saddle so as to maintain substantially stability around the axis; and the first layer 14 being made out of sheepskin having a pelt hair length between $\frac{3}{4}$ inch and 1 inch.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to only employ the pads of Vasko et al. in the front portion depending on where the user wishes to have cushion effect of the pad, in the front or back or both. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

As mentioned above, Woods teaches sheepskin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the first layer of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice. Vasko et al. as modified by Woods are silent about the sheepskin having a pelt hair length between $\frac{3}{4}$ inch and 1 inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheepskin

of Vasko et al. as modified by Woods with a pelt hair length between $\frac{3}{4}$ inch and 1 inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 81, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein said plurality comprises four discrete pads, two per side of the spine, each of said four pads being adapted to cooperate with a recess or gap within the anatomy of the subject. See col.5, lines 5-10.

For claim 82, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein at least one of said pads varies in thickness. See figs. 5-8.

For claim 83, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein at least a portion of said plurality of pads are formed from a visco-elastic foam material. See col. 2, line 67,col. 3, lines 32-48.

For claim 84, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein said plurality of pads are made removable from said pockets via Velcro strips 34,35 disposed at seams of said pockets.

For claim 85, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein said living subject comprises an equine.

For claim 86, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach wherein said apparatus is further adapted to support said saddle while maintaining substantially unimpeded movement of the spinal column of said living subject.

For claim 87, Vasko et al. teach a saddle pad adapted for use with a saddle on a high-withered equine, comprising: first and second substantially flexible elements 14,15,17,18 having roughly the same shape, said first and second elements being bound together in at least a plurality of locations along their periphery, said first element comprising a wool felt or woven nylon fabric and being in direct contact with the skin of said equine; and a plurality of compressible visco-elastic foam pad elements 36,38 disposed between said first and second flexibly elements, said pad elements straddling the spine of said equine at a distance whereby said saddle pad is not in contact with the spinal column of said equine during riding, wherein said pad elements are disposed and configured to substantially fill respective ones of gaps that occur on the anatomy of said high-withered equine in its withers region, thereby substantially relieving this region from excessive pressure and contact with said saddle in a gullet channel which would otherwise exist without said pad elements; and wherein said unimpeded spine movement, said frustration of redisposition, and said first flexible element cooperate to provide reduced discomfort for said equine during said riding. However, Vasko et al. are silent about said first element comprising a thick sheepskin.

As mentioned above, Woods teaches sheepskin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the material 17 of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice.

For claim 88, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach at least one peripheral ridge 19 disposed substantially along a front or back periphery of said first and second elements, said peripheral ridge cooperating with an edge of said saddle to substantially frustrate relative motion between said saddle pad and said saddle in at least one direction during riding.

For claim 89, Vasko et al. teach a saddle pad adapted for use, with a saddle, on an equine, comprising: first and second substantially flexible elements 28,30 having roughly the same shape, said first and second elements being bound together (by binding 19 and seam 20) in at least a plurality of locations along their periphery, said first element comprising wool felt or woven nylon fabric in direct contact with the skin of said equine and said second element comprising a fiber-based material (such as wool felt or woven nylon fabric) disposed to contact said saddle; a plurality of compressible visco-elastic foam pad elements 36,38 disposed between said first and second flexible elements, said plurality of pad elements having a first shape (see figs. 5-8) adapted to straddle the spine of said equine with at least a portion of said plurality disposed within said saddle pad and sufficiently distant from said spine such that the movement of the spine of said equine is substantially unimpeded by said saddle and said pad elements during riding, first and second restraining straps 40-43 affixed to at least said second flexible element, said straps each being adapted for substantially concealed tethering to said saddle; and at least one peripheral ridge 19 disposed substantially along a front or back periphery of said first and second elements, said peripheral ridge cooperating with an edge of said saddle to substantially frustrate relative motion between said saddle

pad and said saddle in at least one direction during riding; wherein said pad elements are adapted to interface only with gaps formed in the withers region of said equine so as to prop up only a front portion of said saddle and provide a substantially invariant relationship between said saddle and said equine during ambulation of said equine (see also col. 5, lines 5-10). However, Vasko et al. are silent about the first element comprising sheepskin in direct contact with the skin of said equine.

As mentioned above, Woods teaches sheepskin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the first element 17 of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice.

For claim 94, Vasko et al. teach an apparatus adapted for use on high-withered animals, comprising: a substantially flexible pad 12 comprising a plurality of pockets 28,30 formed substantially between a first layer 14 comprising wool felt or woven nylon fabric, which are a fiber-based material, respectively; and a second layer 17 comprising fiber-based material (col. 2, lines 45-59); said wool felt or woven nylon fabric being disposed to contact the skin of said high-withered animals, said wool felt or woven nylon fabric, which are fiber-based material, being disposed to contact a saddle; a plurality of visco-elastic foam pad elements 36,38 captured by respective ones of said pockets; wherein said pad elements and said pad cooperatively form a raised feature element to raise a frontal portion of a saddle disposed over top of said pad elements with respect to

a withers region in order to mitigate tilting or rocking of the saddle. However, Vasko et al. are silent about wherein said first layer comprises sheepskin; and wherein said pad elements and said pad cooperatively form a raised feature element to raise only a frontal portion of a saddle.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to only employ the pads of Vasko et al. in the front portion depending on where the user wishes to have cushion effect of the pad, in the front or back or both. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

As mentioned above, Woods teaches sheepskin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the first layer 17 of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice.

For claim 95, Vasko et al. as modified by Woods (emphasis on Vasko et al.) further teach a pad interface 19 (or the thickness of layer 17,18) adapted to interface between said pad and said animal, said pad interface adapted to (i) dissipate localized pressure; (ii) dissipate heat; and (iii) dissipate moisture. Note that claim 95 depends upon a cancel claim 61, thus, this claim is open to different interpretation as to what a pad interface is.

For claims 98, 101, 102, Vasko et al. as modified by Woods are silent about the sheepskin being Australian Merino sheepskin, and the second flexible element being square quilted fabric, said fabric providing reduced bunching of the second element under said saddle during use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ Australian Merino sheepskin as the preferred sheepskin in the pad element of Vasko et al. as modified by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 125 USPQ 416. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ square quilted fabric, said fabric providing reduced bunching of the second element under said saddle during use as the preferred material for the second flexible element in the pad element of Vasko et al. as modified by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 125 USPQ 416.

For claims 99 & 100, Vasko et al. as modified by Woods are silent about wherein said sheepskin comprises a chemical treatments adapted to improve at least one of stain resistance or ultraviolet fading of said sheepskin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a chemical treatment to the sheepskin of Vasko et al. as modified by Woods in order to

treat the sheepskin to rid of bacteria in the sheepskin, which is a known technique employed in leather or fur treatment. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

Response to Arguments

8. Applicant's arguments filed 8/27/07 have been fully considered but they are not persuasive.

Applicant argued that Applicant submits that neither Vasko nor Woods (US 5,802,823) remotely teach or suggest pads being configured to raise the saddle at least partly off of only the withers region or only a front portion of the withers region of the animal.

The claim language of "configured" is function recitation, to which the pads of Vasko and/or Woods are capable of performing that function. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2114, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim. The intended use of an apparatus is not a relevant limitation with respect to the patentability of the structure defined in an apparatus claim. In re Yanush, 477 F.2d 958, 959, 177 USPQ 705,706 (CCPA 1973). Note that in col. 5, lines 5-10 of Vasko et al., they state that there can be multiple pockets with inserts therein (which is similar to the configuration of the pads and pockets in fig. 3d of Applicant's drawings) or a single pocket with multiple pads. Thus, if a rider wishes to have only the front pads inserted, then, he/she can do so because the pads of Vasko et al. are capable of performing the configured to raise only the front portion of the withers region, especially when the pads are designed to be removably inserted into the pockets.

As mentioned in the 112 1st rejection above, Applicant has no support for the pad raising only the withers region of the animal because Applicant's pad element, not only cover the withers region, but also the back area of horse. Clearly from figs. 3a,3d, pads 304a,304b,320a,320b, 321a,321b are located along the whole length of the pad apparatus 300 and located at the front and back portions of the pad apparatus. No where in the specification and shown in the drawings that ONLY the front portion of the withers region is being covered by the pads.

Applicant employed numerous intended use and functional recitation throughout the claims, the pads of Vasko et al. or Woods can perform those functions or intended

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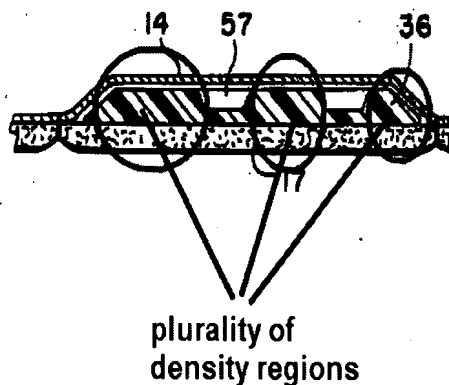
use. For example, in claim 70, the phrases “adapted to support a saddle while maintaining both substantially unimpeded movement of the spinal column of a living subject and a desirable balance of a saddle and rider”, so that said saddle pad apparatus does not impede movement of the spinal column of said living subject by forming a space between said spinal column and said saddle pad apparatus”, “being adapted to individually cooperate with one or more a respective one of withers region gaps or recesses of the anatomy of the living subject”, “configured to raise the saddle at least partly off of only said withers region of the animal, so as to substantially avoid contact of said saddle with the top of the withers, thereby substantially eliminating pressure points in said withers region and maintaining said balance”, are ALL functional and intended use recitation, which are not given patentable weight, especially when the prior art’s pads can perform the same function or intended use.

There is nothing special in the features of the pad device of Applicant that is any different from that of Vasko et al. because both teaches a pad device with pockets where pads are inserted. The pockets can be one single pocket located on each side of the pad device with pads extending from the front to the back areas (as shown in fig. 3a of Applicant and figs. 1-2 of Vasko et al.). Or, the pockets can be a plurality of pockets to hold each pad therein (as shown in fig. 3d of Applicant and disclosed in col. 5, lines 5-10 of Vasko et al.). Thus, there is NO difference in the two inventions. Everything else claimed is intended use or functional recitation. Just because Vasko et al. do not list all intended use of their pads do not mean that the pads aren’t capable of performing those functions. All function recitation as claimed by Applicant are clearly capable of being

performed by the Vasko et al.'s pads. Even in light of Applicant's specification in regards to the shape of the inserts 320 being somewhat angled, Vasko et al. even teach that shape (see their drawings of the pad, especially figs. 5-8, it is angled or "somewhat" angled, such that the edges are pointed downward).

Applicant argued that Applicant's claim specifically states that the pad has a plurality of densities in its uncompressed state. Vasko in no way teaches or suggests multiple densities when the pad is uncompressed.

A plurality of densities isn't even specified in the specification, thus, the Examiner can interpret a plurality of densities as broadly possible within the scope of the word density. Each area occupied by the mass of foam for the pad of Vasko et al. occupies a density region, thus, the whole pad contains a plurality of density regions or densities. Density is mass per unit volume, thus, the mass of the foam material occupying each region or volume of the pad is density regions. For example, see illustration below.



Applicant argued that as noted by the Examiner, Vasko in no way teaches or suggests sheepskin. Woods in no way teaches or suggests any particular selection, type, thickness, or properties of the sheepskin that Applicant can find.

Applicant further submits that its selection of the recited pelt hair length is not merely an obvious choice by the ordinary artisan; substantial experimentation and effort was made by Applicant in identifying the appropriate length and properties for the sheepskin. Similarly, Applicant also notes that "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.

Length of pelt hair on sheepskin being claimed would clearly be obvious based on experimentation and testing to find the right range of length for the intended use. Applicant has not even provided any evidence as required by MPEP chapter 2100 to state the source of the problem and those in the same field of endeavor have repeatedly tried and failed to find pelt hair of $\frac{3}{4}$ to 1 inch in length for sheepskin. Clearly, finding the right length for pelt hair on sheepskin would have been obvious to one skill in the art through routine experimentation and testing. Should a patent be given if another inventor comes along and claim pelt hair of length 1.5 to 3 inches because he claims that he as solve a problem long standing in the art, to which this length provide more comfort for the horse?

All other arguments regarding Applicant's statement of "solving a source of a problem" are addressed similar to the above comments. Again, there is no evidence provided by Applicant as required by MPEP 2100 to state the source of the problem and those in the same field of endeavor have repeatedly tried and failed to solve the problem.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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